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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/685,750   | 10/15/2003  | Mark Budzik          | TRI4546P0170US      | 6164             |
| 32116  | 7590        | 09/22/2005           | EXAMINER            |                  |
| WOOD, PHILLIPS, KATZ, CLARK & MORTIMER<br>500 W. MADISON STREET<br>SUITE 3800<br>CHICAGO, IL 60661 |             |                      | SPAHN, GAY          |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3673                |                  |

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/685,750

Applicant(s)

BUDZIK, MARK

Examiner

Gay Ann Spahn

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 11-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

In the first paragraph of Applicant's Remarks starting on page 4 of his Request for Reconsideration filed on 24 May 2005, Applicant acknowledges his election of the invention of Group I (i.e., claims 1-12, drawn to a drywall trimming accessory, classified in class 52, subclass 255). However, Applicant failed to acknowledge his election of the species of Figs. 1-2 (i.e., claims 1-10). See pages 3-4 of Office Action mailed 05 May 2005 and more particularly, the first full paragraph on page 4, wherein the examiner discusses her telephone conversation with Attorney Allen J. Hoover on 16 March 2005, during which Attorney Hoover provisionally elected, with traverse, to prosecute the invention of Group I and the species of Figs. 1-2.

In the fourth paragraph of Applicant's Remarks starting on page 4 of his Request for Reconsideration filed on 24 May 2005, the Applicant states as follows:

. . . It is noted that the Office Action has neglected to discuss claims 11 and 12. As indicated in the restriction requirement, claims 11 and 12 are part of invention 1. Applicant has elected invention 1 and therefore, claims 11 and 12 are pending. Further consideration of these claims is respectfully requested.

While the examiner agrees with Applicant that claims 11 and 12 remain pending, she clearly stated on page 4, lines 6-10, of the Office Action mailed on 05 May 2005 that "[c]laims 13-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention and claims 11 and 12 are

withdrawn from consideration (until such time as a generic claim is found to be

**allowable) as being drawn to a non-elected species.** (Emphasis added). Thus, the examiner did not "neglect to discuss claims 11 and 12" as indicated by the Applicant, but clearly told the Applicant that those claims were being withdrawn from further consideration as being drawn to a non-elected species. Claims 11 and 12 will be rejoined at such time as a claim generic to all species and on which claims 11 and 12 depend is found allowable.

It is noted that Applicant failed to comply with the sentence on page 3, lines 8-10, of the Office Action mailed on 05 May 2005 wherein it states that "Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added." However, in lieu of sending Applicant a non-responsive, the examiner will proceed with another Office Action on the merits.

Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement and the election of species requirement, the Applicant's provisional election has been treated as an election without traverse (MPEP § 818.03(a)).

The restriction requirement and election of species requirement are still deemed proper and are therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenig, Jr. et al. (U.S. Patent Application Publication No. 2002/0134035 A1 published on September 26, 2002) in view of Hawley's Condensed Chemical Dictionary and Hoffmann, Sr. (U.S. Patent No. 6,684,586).

Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having a flange (30), which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer (see lines 1-2 of abstract - "extruded from a polymeric material, such as polyvinyl chloride").

The examiner notes that Hawley's Condensed Chemical Dictionary (Eleventh Edition, revised by N. Irving Sax and Richard J. Lewis, Sr., published by Van Nostrand Reinhold Company, Inc., New York, © 1987) defines "foams, plastic" (page 534) as follows:

A cellular plastic which may be either flexible or rigid. Flexible foams may be polyurethane, rubber latex, polyethylene or vinyl polymers, rigid foams are chiefly polystyrene, polyurethane, epoxy, and polyvinyl chloride. . . . (Emphasis added).

Thus, Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride is considered to meet the claim recitation of a cellular polymer. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular,

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or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 1's limitation that at least part of at least one of the expansive surfaces of the flange is characterized by open cells of the cellular polymer.

Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 2, Hoffmann, Sr. also discloses that the same part of the same one of the expansive surfaces of the flange is contacted by a drywall-finishing compound, which penetrates said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least a part of at least one of the expansive surfaces of the flanges thereof and contacting the same part of the same one of the expansive surfaces of the flange thereof to a drywall-finishing compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer to the drywall compound so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 3, Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having a flange (30), which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from Hawley's Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 3's limitation that at least part of each expansive surface of the flange is characterized by open cells of the cellular polymer.

Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 4, Hoffmann, Sr. also discloses that the same part of each expansive surface of the flange is contacted by a drywall-finishing compound, which penetrates said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least part of each expansive surface of the flange thereof and contacting the same part of each expansive surface of the flange thereof with drywall compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 5, Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having two diverging flanges (30, 30), each of which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from Hawley's Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 5's limitation that at least part of at least one of the expansive surfaces of each flange is characterized by open cells of the cellular polymer.



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Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 6, Hoffmann, Sr. also discloses that the same part of the same one of the expansive surfaces of each flange is contacted by a drywall-finishing compound, which penetrates said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least part of at least one of the expansive surfaces of each flange thereof and contacting the same part of the same one of the expansive surfaces of each flange thereof with drywall compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 7, Koenig, Jr. et al. disclose a drywall-trimming accessory (strip 10) having two diverging flanges (30, 30), each of which has two expansive surfaces (32, 24) facing oppositely, wherein the drywall-trimming accessory (strip 10) is made from a cellular polymer.

As stated above with respect to the rejection of claim 1, the examiner considers that Koenig, Jr. et al.'s disclosure of his drywall-trimming accessory (strip 10) being made of polymeric material such as polyvinyl chloride meets the claim recitation of a cellular polymer based on the definition of "plastic foams" from Hawley's Condensed Chemical Dictionary. However, it certainly would have been obvious to form the polyvinyl chloride (PVC) trimming strip (10) of Koenig, Jr. et al. from a cellular, or open cell, polyvinyl chloride (PVC), since such is a well known and highly utilized polyvinyl chloride (PVC) as expressed by Hawley's Condensed Chemical Dictionary.

Koenig, Jr. et al. fail to disclose claim 7's limitation that at least part of each expansive surface of each flange is characterized by open cells of the cellular polymer.

Hoffmann, Sr. discloses a strip of polymer material that is used as a corner bead or drywall tape (abstract, lines 1-2). Further, at col. 2, lines 19-22, Hoffmann, Sr. discloses that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

As to claim 8, Hoffmann, Sr. discloses that the same part of each expansive surface of each flange is contacted by a drywall-finishing compound, which penetrates said cells (i.e., the roughened surface is exposed to drywall compound and the drywall compound is readily absorbed by the roughened surface).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least part of each expansive surface

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of each flange thereof and contacting the same part of each expansive surface of each flange thereof with drywall compound as taught by Hoffmann, Sr. in order to increase the surface area and thus expose the open cells of the cellular polymer so that the drywall trimming accessory would be better able to absorb the drywall compound.

As to claim 9, Koenig, Jr. et al. disclose that the drywall-trimming accessory is an elongate strip.

As to claim 10, Koenig, Jr. et al. disclose that the polymeric material is polyvinyl chloride.

### ***Response to Arguments***

Applicant's arguments filed 24 May 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, (more particularly, that there is no suggestion to form the Koenig, Jr. et al. corner strip of a cellular polyvinylchloride), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one having ordinary skill in the art at the time the invention was made would have found the suggestion to form a corner strip of Koenig, Jr. et al. from a

cellular polyvinylchloride, (including closed as well as open cell), within the general knowledge in the art as evidenced by Hawley's Condensed Chemical Dictionary. Whether forming the Koenig, Jr. et al. corner strip of an open or closed cell polyvinylchloride, the cells of the cellular polyvinylchloride, would be exposed upon milling or knurling the surface of the corner strip.

### ***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (571)-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gay Ann Spahn, Patent Examiner  
September 18, 2005



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